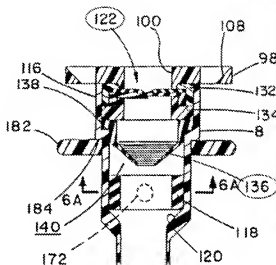


REMARKS

The claims have been amended as indicated above. The amendments are being made to clarify the invention. The amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

102 Over Haber

The Office Action rejected claims 25-40 under 35 U.S.C. 102(b) as being anticipated by Haber (US Patent No. 5,385,552). Applicants traverse these rejections and request reconsideration because this cited portions of Haber do not teach or suggest the combination as currently claimed. A portion of Fig. 4 illustrating the seal structure of Haber is reproduced here with relevant numerals circled. Haber uses two seals: a proximal seal (122) and a distal seal (136). The proximal seal (122) is intended to seal the trocar when an instrument is not positioned in the path (see 6:1-2, 7:39-42, 8:21-22). The proximal seal (122) would be referred to in the art as a “zero-closure seal”. In contrast, the distal seal (136) is conical and intended to seal against surgical instruments when they are positioned in the trocar (see 6:34-37, 7:46-48). The distal seal (136) would be referred to in the art as a “instrument seal”. Accordingly, the distal seal (136) is intended to seal against instruments, not the proximal seal (122).



The Office Action is premised on inaccurate conclusions about Haber. Specifically, the Office Action states,

Haber discloses (figures 2 and 5A) a surgical access device (2), comprising a seal assembly (124, 136) having a plurality of separate semicircular seal segments arranged in a conical shape, each seal segment having a circumference greater than 180 degrees and being adapted to seal against objects positioned through the seal.”

Office Action at 2 (emphasis added). Applicants respectfully disagree on two counts. First Haber does not teach or suggest a seal having plurality of separate semicircular seal segments arranged

in a conical shape. Plainly, the proximal seal (122) is not arranged in a conical shape, but rather is arranged in a planar configuration. The distal seal (136), which is a separate and distinct component from the proximal seal (112), is conical but plainly does not have a plurality of separate semicircular seal segments. Since the rejection is based on this inaccurate reading of Haber, Applicants request reconsideration.

Second, the proximal seal (122) of Haber is not adapted to seal against objects as asserted in the Office Action. Haber makes clear that the proximal seal (122) is intended to seal the trocar when an object is not positioned in the path. Instead, Haber requires the addition of the distal seal (136) to seal against surgical instruments. Accordingly, Haber actually teaches away from the invention as presently claimed because Haber requires a separate instrument seal. Since the rejection is based on this inaccurate reading of Haber, Applicants request reconsideration.

In contrast to Haber, the presently claimed invention seals against instruments sufficient to maintain pneumoperitoneum (but not necessarily hermetic). Consider independent claim 25 that recites, “a plurality of separate semicircular seal segments arranged in a conical shape . . . adapted to seal against objects positioned through the seal.” Also in contrast to Haber, independent claim 30 recites, “a plurality of semicircular elastomeric members compressed therebetween and forming a conical shape, the elastomeric members circumscribing an aperture in an interwoven pattern and cooperate to sufficiently seal against objects positioned within the aperture to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures.” Also unlike Haber, claim 34 recites, “a plurality layered elastomeric members arranged circumferentially about an aperture in an alternating over and under pattern and forming a conical shape, the plurality layered elastomeric members cooperating to provide a substantially gas-tight seal against instruments positioned through the aperture.” Since these and other features recited in the independent claims are not taught or suggested in the cited portions Haber, all the independent claims are novel over Haber and should be in a condition for allowance.

Dependent Claims

Claims 26-29, 31-33, and 35-40 should also be in a condition for allowance by depending from allowable independent claims. Applicants note, however, that the dependent claims recite further limitations that distinguish over the art of record. For instance, consider claim 33 that

recites, “The trocar according to claim 30 wherein said plurality of elastomeric members have a non-planar shape prior to be assembled together.” The Office Action stated,

With regards to new claims 33, Haber discloses (figures 2 and 5A) the trocar according to claim 30 wherein said plurality of elastomeric members have a non-planar shape prior to be assembled together.

Office Action at 3. Applicants respectfully disagree as the four elastomeric sealing elements (126) Haber are shown as being planar.

Double Patenting

The Office Action provisionally rejected claims 25-40 under the judicially created doctrine of obviousness-type double patenting over claims 1-32 of copending Application No. 10/815356. Applicants traverse this rejection and request reconsideration. A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Applicants submit that the cited combination fails to establish a *prima facie* case of obviousness, and therefore the obviousness-type double patenting rejection is improper. Indeed, the Office Action makes an unsupported statement that the claims are obvious without any analysis. Nevertheless, to facilitate an early notice of allowance Applicants are prepared to submit a Terminal Disclaimer under 37 C.F.R. 1.321(c). While the terminal disclaimer would render moot the obviousness-type double patenting rejection, Applicants traverse the rejection and reserve all rights and arguments.

Copending Applications

The Examiner should note the following copending United States patent applications:

<u>Application</u>	<u>Status</u>
10/815356	08-29-2008 CTNF Non-Final Rejection
10/943215	11-07-2008 N/AP Notice of Appeal Filed

10/943214	10-08-2008 CTNF Non-Final Rejection
10/943221	10-14-2008 CTFR Final Rejection
10/943222	10-16-2008 A... Amendment/Req. Reconsideration-After Non-Final Reject
10/943220	09-29-2008 CTFR Final Rejection
11/217673	11-19-2008 A... Amendment/Req. Reconsideration-After Non-Final Reject
10/943218	07-29-2008 CTFR Final Rejection
10/943213	08-11-2008 A... Amendment/Req. Reconsideration-After Non-Final Reject

The foregoing statuses were pulled from PAIR on 12/08/2008. The Examiner is encouraged to review each of these file wrappers, including the pending claims, all art of record, and any rejections. Details of these cases are available through PAIR and the Office's databases. No representation is made or intended that the foregoing cases are material to patentability of the present claims, or that the foregoing list is comprehensive.

Conclusion

Based on the foregoing, all of the pending claims are in a condition for allowance. Applicants traverse all rejections and request reconsideration, and Applicants request an early notice of allowability.

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Respectfully submitted,

/Victor Moreno/
Victor C. Moreno (Reg. No. 40,732)
Attorney of Record

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933
Tel: (513) 337-7158

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